

**Application Serial No. 10/587,710**  
**Docket No. 1093-160 PCT/US**  
**Response to October 28, 2009**  
**Non-Final Office Action**

### **REMARKS**

The Non-Final Office Action mailed October 28, 2009 and the references cited therein have been carefully considered. Claims 1-18 are now pending in the present application and Claims 19-28 have previously been withdrawn from consideration. By the amendments herein, Applicant has currently amended Claims 1, 3, 4, 12, 22 and 26. The Amendments to Claims 1 and 3 merely eliminate limitations to one of the alternative configurations. Also, the amendments to Claim 4 are intended by Applicant to accept the allowable subject matter indicated by the Examiner in the subject Office Action, thereby rewriting Claim 4 into independent form including all the limitations of the base claim. Additionally, the amendments to Claims 12, 22 and 26 merely removed reference numerals inadvertently not omitted in the Preliminary Amendment. Claims 22 and 26 remain withdrawn from consideration. Accordingly, no new matter has been introduced by the amendments herein. Applicant responds below to the issues raised in the subject Office Action.

### **Provisional Double Patenting Rejection**

Claims 1-4, 6 and 13-18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-11 and 20 of co-pending Application Serial No. 10/576,098 in view of International Published Application WO 00/50249 to **Plaschka** et al. (as translated by U.S. Patent No. 7,040,663) and U.S. Patent No. 6,491,324 to **Schmitz** et al. In response, Applicant has submitted a Terminal Disclaimer herewith in compliance with 37 C.F.R. § 1.321 to overcome the provisional double patenting rejection.

Therefore, it is respectfully submitted that the rejection of Claims 1-4, 6 and 13-18 on the ground of nonstatutory obviousness-type double patenting has been overcome.

**Claim Rejections under 35 USC § 103**

Claims 1-3, 5, 12-15 and 18 are rejected under 35 U.S.C. §103 as being unpatentable over Schmitz in view of U.S. Patent No. 5,821,971 to **Kaule** et al. Additionally, Claim 6 is rejected under 35 U.S.C. §103(a) as being unpatentable over Schmitz and Kaule, and further in view of U.S. Published Application 2004/0190102 to **Mullen** et al. Further, Claims 7-9 are also rejected under 35 U.S.C. §103 as being unpatentable over Schmitz in view of Kaule, but further in view of U.S. Published Application 2004/0256986 to **Yadav**. Further still, Claims 10 and 11 are rejected under 35 U.S.C. §103 as being unpatentable over Schmitz in view of Kaule and yet further in view of EP0953937 to **Power** et al. Even further still, Claims 16 and 17 are rejected under 35 U.S.C. §103 as being unpatentable over Schmitz and Kaule, and further in view of WO 99/65699 to Harris et al. Applicant respectfully traverses these rejections.

Schmitz discloses a security document such as a bank note or the like with a security element having at least one mechanically detectable magnetic layer and at least one further layer. Part of the Schmitz disclosure includes a carrier foil 7 that includes a release layer 8, a cover layer 6, a magnetic layer 5 and an adhesive layer 9 as shown in Figure 2. The Schmitz disclosure, particularly at column 4, lines 44-51, goes on to describe that the security element can be made as a label-like security element to be transferred in certain places with the aid of such a transfer foil. It is, however, clear from the disclosure of Schmitz that all of the elements of the

transfer foil are assembled on the transfer foil before being applied to security document. There is clearly no suggestion in Schmitz that some of the elements of the security feature need not be assembled on the transfer foil, but rather can already be present on the security document. In fact, it is admitted in the subject Office Action that Schmitz fails to disclose that the adhesive layer is applied directly to the target substrate rather than to the transfer film. Additionally, it is admitted in the Office Action that Schmitz fails to disclose that the radiation-curable adhesive is crosslinkable adhesive.

While Schmitz discloses a film body that includes a partial magnetic layer, that magnetic layer is applied by printing or by coding (see Schmitz column 8, lines 32-37. The mode of transfer of security elements as taught by Schmitz involves a transfer of the whole security element onto a security document. Thus, Schmitz does not at all teach or suggest a transfer process using a pattern form to remove a partial aspect of security elements to the final security document. In other words, Schmitz relates to a laminating foil which is placed in its entirety onto the security document. Thus, this can in no way be interpreted as a process where the magnetic layer remains on the first film body in a first region structured in pattern form and in a second region structured in pattern form the magnetic layer remains on the carrier film and is removed with the carrier film from the first film body as recited in Claim 1. Thus, the disclosure of Schmitz would lead one of ordinary skill away from the subject matter of the claimed invention where the magnetic layers formed through the production process through the transfer process in production.

Kaule is cited for teaching a security document where the replication lacquer layer has a diffractive structure consisting of a radiation-durable layer and where the adhesive layer serves to fasten the security element onto the security document such as a bank note. The adhesive layer consists of a UV-hardenable adhesive and the replication lacquer layer similarly consists of a UV-hardenable material. It should be noted, however, that the reactive adhesive and lacquer layers as taught by Kaule are used to secure and remove all the security features from the carrier foil. In particular, in Kaule Col. 5, lines 27-38 (referring to Figs. 2 and 3) it is made clear that the embossing element 9 (shown in Fig. 2) is secured by adhesive 4 to the substrate and then the carrier band 5 is removed. Note that Kaule refers in that paragraph to a last step where the “security elements 9” are on the substrate, but only refers to the non-transferred remains of element layer 9 removed with the carrier band 5. In other words, no portion of the security elements, such as a magnetic layer remain on the carrier band.

An aspect of the claimed invention includes the adhesive layer being applied “in a form structured as a first pattern.” Also, once “the carrier film is removed from the second film body” a portion of the magnetic layer remains on the first film body, while another portion remains on the carrier film. In this way, the first pattern in which the adhesive is applied controls the pattern of the magnetic layer that is removed from the carrier film. One of ordinary skill would not be motivated to combine the teachings of Schmitz and Kaule to arrive at this aspect of the claimed invention as suggested in the subject Office Action. This aspect is further defined in Claim 2, which includes the limitations with regard to alternative a) that the adhesive is applied in a

pattern form to the first film body and that after the adhesive is hardened by radiation. The carrier film is removed leaving regions of the magnetic layer on the first film body. While Schmitz may disclose the application of the magnetic layer in limited areas, it clearly does not disclose the application onto the security document by means of removing only limited portions of the magnetic layer as recited in Claim 2. In fact, neither Schmitz nor Kaule even hint at a process for producing individual layers of the security element, particularly the magnetic layer, through selective removal thereof from the carrier film.

Additionally, there is simply no teaching or suggestion in either Schmitz or Kaule with regard to alternative b) as recited in claim 1. This aspect relates to applying “to the first film body in a formed structure as a first pattern and irradiating in a pattern formed differently from the first pattern.” Accordingly, the combination of Schmitz and Kaule fails to teach all the aspects of the claimed invention according to amended claim 1.

What is more, none of the further cited prior art references teach or reasonably suggest the missing elements noted above. None of the cited prior art documents disclose the process for the production of a security element for value documents that includes the particular application of an adhesive layer and magnetic layer and partial removal thereof as recited in the claims. Also, the further prior art does not teach or suggest using different patterns for the application of the adhesive layers from the way the first film body is irradiated. Also, one of ordinary skill would have no reason to further modify the cited prior art to arrive at the claimed invention.

Applicants further submit that Claims 2, 3 and 5-18, which ultimately depend from Claim 1 are similarly patentable over the art of record by virtue of their dependence. Also, Applicant submits that Claims 2, 3, and 5-18 define patentable subject matter in their own right. Accordingly, Applicant respectfully requests reconsideration from withdrawal of the rejections of Claims 1-3 and 5-18 under 35 U.S.C. §103(a).

**Allowable Subject Matter**

The subject Office Action indicated that Claim 4 would be allowed if rewritten in independent form including all the limitations of the base claim. Thus, Applicant, in an effort to accept the allowed subject matter, has converted Claim 4 to independent claim format, thus incorporating all the limitations of Claim 1 as originally filed. The one minor exception in this regard is that the recitation in the preamble relating to bank notes, credit cards, etc. has been intentionally omitted in view of the Examiner's indication that this subject matter was not given any patentable weight.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the objection of Claim 4 as it is now in allowable form.

**Conclusion**

Entry of the amendments herein and favorable consideration of Claims 1-18 is hereby solicited. In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner has

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any questions or suggestions to expedite allowance of this application, the Examiner is cordially invited to contact Applicant's attorney at the telephone number provided.

Respectfully submitted,

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